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REMARKS

In the Office Action, the Examiner The Examiner noted that claims 1-43 are pending in the application, that claims 1-11 and 34-43 are withdrawn from consideration, and that claims 12-33 are rejected.

By this Amendment, claims 1-11 and 34-43 have been cancelled, claim 29 has been amended, and new claims 44-46 have been added. Therefore, claims 12-33 and 44-46 are pending in the application. The Examiner's rejections are traversed below.

Rejection Under 35 USC Section 112, Second Paragraph

Claim 29 is rejected as being indefinite. Applicant considers claim 29 as being sufficiently clear. Nevertheless, Applicant has amended claim 29 to correct informalities.

Withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. Section 102

Claims 12-33 are rejected as anticipated by Multer et al. (U.S. Patent 6,738,789: Data package including synchronization data).

Applicant respectfully disagrees.

Multer et al. relates to a data package containing instructions for manipulating user data. The package includes a header identifying the data package and containing information on

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content in the data package; transaction objects operable to effect a change to user data; and object operation instructions. At Column 8, lines 30-36, Multer et al. describes that in "a particular unique aspect of the present invention, **only those changes to the information which are required to be forwarded to other systems on the system of the present invention are transmitted to enable exceptionally fast response times.**"

On page 3 of the Office Action, in connection with the rejection of independent claim 12, the Examiner contends Multer et al. shows a bundle consisting of a data element reference and meta data that describes the data element at Column 10, lines 25-42. Applicant disagrees. Multer et al. merely discloses that each "data package describes changes to any and all transfer information across all device engines, including but not limited to application data, files, folders, application settings, and the like." Accordingly, nothing in Multer et al. describes the claimed bundle consisting of a data element reference and meta data that describes the data element.

In addition, the claimed information bundle is different than the "data package" of Multer et al. Specifically, Multer et al. describes at Column 38, lines 32-50, that

"[d]ata packages can be provided in a binary data format. This allows data packages to encode changes to non-application data at a byte level. Hence, if a single bit on a system changes, the system of the present invention allows synchronization of that bit on another system. Changes are described as a sequence of byte-level change operations."

Accordingly, Multer et al. also fails to disclose the claimed information bundles of the present invention that is irrelevant to synchronization of bit changes on the byte level.

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The Examiner further contends that Multer et al. discloses at Column 40, that the data elements are resident on a node of a data owner. However, **Multer et al. discloses no such information.** Rather, at Column 39, lines 60-68, Multer et al. discloses that "[t]he general architecture of the package provides for transactions, application data, file data, files, objects and identifiers to be carried in the data package. Generally, transactions, application data, file data, and files have previously been described." Accordingly, **Multer et al. also fails to disclose the claimed data elements resident on a node of a data owner.**

The Examiner also contends that Multer et al. discloses at Columns 11-13 the claimed step of "distributing copies of the data elements in the bundles assembled in the step of assembling from the network node of their respective data owners to the network nodes of accessors, following selection of the data elements by the accessors." However, Column 11, lines 17-55, recite the following:

The application object is a pluggable architecture which supports a wide variety of vendor-unique applications. The job of the application object is to map data from the application into a temporary or "universal" data structure by connecting to the application via any number of standard interfaces to gain access to the applications data. The data structure of the application object puts the data in a generic or "universal data" format which may be used by the device engine components to generate data packages for provision to the storage server. . . . Hence, during a sync, the Application Object will, using a mechanism discussed below, extract the data of each application in the device and convert it to a universal data format.

Therefore, **nothing in Multer et al. shows or suggests** the claimed step of distributing copies of the data elements recited in claim 12.

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Specifically, without conceding that the cited prior art discloses any of the elements of the present invention recited in claim 12, Applicant respectfully submits that the prior art does not show or suggest the combination of limitations in claim 12, when claim 12 is interpreted as a whole. For example, claim 12 recites the following, in combination, a "networked commercial interaction management method." Multer et al. does not show or suggest a commercial interaction management. In addition, as described above, Multer et al. does not disclose the claimed step of "assembling information into bundles, wherein each bundle consists of a data element reference and meta data describing the data element, and wherein each data element remains resident on a node of a data owner in a network." Further, Multer et al. does not disclose "distributing the meta data from the bundles through the network, and distributing copies of the data elements in the bundles assembled in the step of assembling from the network node of their respective data owners to the network nodes of accessors, following selection of the data elements by the accessors."

Accordingly, Applicant submits that the combination of limitations recited in claim 12 patentably distinguishes over the prior art cited by the Examiner. Withdrawal of this rejection is respectfully requested.

In addition, Applicant respectfully submits that dependent 13-18, 20, 21, 24-26, 28 and 31 also patentably distinguish over the prior art for the specific combination of limitations recited in each of the claims, when each claim is interpreted as a whole, as well as the arguments provided below. Withdrawal of the rejection of these claims is respectfully requested.

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The Examiner further cites inherency in the rejection of claims 14, 17, 21, 26 and 31. Applicant disagrees and respectfully submits that the Examiner's inherency reasoning is circular. Specifically, with respect to claim 14, the Examiner has not explained why the step of "negotiating trusted relationships between owners and accessors is inherent in Multer et al. The Examiner has not cited any section of Multer et al. for which any inherency can be applied. Thus, for this reason, withdrawal of the rejection of claim 14 is respectfully submitted.

With respect to claim 17, the Examiner has not explained why the step of "defining meta data elements in response to owner input" is inherent in Multer et al. The Examiner has not explained why the mere inclusion of web browser client 808 would include meta data denied in response to owner input. Thus, for this reason, withdrawal of the rejection of claim 17 is respectfully submitted.

With respect to claim 21, the Examiner has not explained why the step of "accessors with entitlements to both the bundle and its superbundle" is inherent in Multer et al. The Examiner has not explained why the UUID would necessarily include information relating to access to a superbundle and a bundle associated therewith. Thus, for this reason, withdrawal of the rejection of claim 21 is respectfully submitted.

With respect to claim 26, the Examiner has not explained why the claimed feature of bundles referencing other bundles is inherent in Multer et al. The Examiner has not cited any section of Multer et al. for which any inherency can be applied. As stated by the Board in

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Ex parte Schricker, 56 USPQ2d 1723, 1725 (B.P.A.I. 2000) (unpublished), on this issue:

Claimed subject matter can be anticipated because a prior art reference describes a method which inherently meets the limitations of a claimed method. . . . However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. Compare *In re Rijckaert*, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art) (citing *In re Yates*, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (C.C.P.A. 1981)).

Thus, for this reason, withdrawal of the rejection of claim 26 is respectfully submitted.

With respect to claim 31, the Examiner has not explained why the claimed feature of peer-to-peer is inherent in Multer et al. The **Examiner has not explained** why an Internet connection necessarily includes peer-to-peer. Assuming arguendo that the Examiner's characterization of Internet connection 710 has any relevance to a transfer protocol, there are a number of different types of Internet connections. Therefore, Internet connection 710 **would not necessarily include peer-to-peer transfer.**

In re Robertson, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991))

If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter **is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.**" . . . "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

Thus, for this reason, withdrawal of the rejection of claim 21 is respectfully submitted.

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In addition, with respect to the rejection of claim 13, the Examiner confuses the distribution to anyone that decrypts the data package with the claimed feature of "each bundle includes security information identifying entitled accessors of the data, and wherein the step of distributing only distributes the bundle to the entitled accessors." That is, in at least one embodiment of the present invention, the data bundle is distributed only to the appropriate recipients/accessors, rather than to both people having an encryption key and others not. Thus, for this reason, withdrawal of the rejection of claim 13 is respectfully submitted.

With respect to the rejection of claims 23 and 31, the Examiner states that the prior art is "capable" of performing the recited functions, and therefore, admits that these features are not disclosed in Multer et al. Specifically, the Federal Circuit has stated in this connection in *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) the following:

In finding anticipation by inherency, the Board ignored the foregoing critical principles. The Board made no attempt to show that the fastening mechanisms of Wilson that were used to attach the diaper to the wearer also "necessarily" disclosed the third separate fastening mechanism of claim 76 used to close the diaper for disposal, or that an artisan of ordinary skill would so recognize. It cited no extrinsic evidence so indicating.

Instead, the Board ruled that one of the fastening means for attaching the diaper to the wearer also could operate as a third fastening means to close the diaper for disposal and that Wilson therefore inherently contained all the elements of claim 76. . . . The Board's theory that these two fastening devices in Wilson were capable of being intermingled to perform the same function as the third and first fastening elements in claim 76 is insufficient to show that the latter device was inherent in Wilson. Indeed, the Board's analysis rests upon the very kind of probability or possibility – the odd use of fasteners with other than their mates – that this court has pointed out is insufficient to establish inherency.

Thus, for this reason, withdrawal of the rejection of claims 23 and 31 is respectfully submitted.

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Rejection Under 35 USC Section 103

Claims 12-33 are rejected as obvious in view of, Multer et al. (U.S. Patent 6,738,789: Data package including synchronization data) and/or in combination with Wacławski et al. (U.S. Patent 6,128,628: Meta data processing for converting performance data into a generic format).

Applicant respectfully traverses this rejection.

Wacławski et al. relates to a system and method for processing performance metric data and converting the data from Universal/Uniform Data Format (UDF) to a form readable by data analysis/reporting tools. Performance metric data are collected by collection agents in UDF files. Universal/Uniform Data Format files produced by the same type of collection agent are reformatted and mapped to a dataset having a number of records or observations.

Regarding claims 19, 22, 27, 30, 32 and 33, the Examiner has not provided any reasoning whatsoever regarding this rejection. Withdrawal of this rejection is therefore requested.

Regarding claims 30, 32, and 33, the referenced portion of Wacławski et al. with respect to the meta processor does not at all appear related to the present invention. The Examiner has provided no explanation how processor 210 detects, blends and/or filters data bundles. In addition, the motivation provided by the Examiner regarding "ease of human readable labeling"

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is not understood. This does not all appears to provide any motivation regarding the presently claimed invention. Withdrawal of this rejection is respectfully requested.

In addition, the Examiner cites Judicial Notice of Design Choice with respect to the rejection of claims 19, 22 and 27. Applicant traverses these rejections. With respect to claim 19, there is no such independent basis as "design choice" for which to base an obviousness rejection. For example, Patent Office regulations specifically state the following in the MPEP:

Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). . . . The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

MPEP § 2144.03. Accordingly, Applicant requests the Examiner to provide an affidavit under 37 C.F.R. Section 1.104(d)(2) detailing the reasons why it is well known, or to provide a prior art reference showing this feature. In the absence of either, Applicant requests the Examiner to withdraw the rejection.

With respect to claim 22, Applicant traverses this Official Notice. Applicant does not understand the relevancy of the Examiner's statement with respect to Lexis searching to the claimed step of "presenting alternative content to recipients who lack entitlement to both the bundle and the superbundle." The Examiner has also not provided any motivation to combine the Official Notice with the remaining prior art references. Accordingly, Applicant requests the

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Examiner to provide an affidavit under 37 C.F.R. Section 1.104(d)(2) detailing the reasons why it is well known, or to provide a prior art reference showing this feature. In the absence of either, Applicant requests the Examiner to withdraw the rejection.

With respect to claim 27, Applicant traverses this Official Notice. Applicant does not understand the relevancy of the Examiner's statement that replied-to-referencing is standard. Applicant disagrees, particularly since claim 27 recites, in combination, the "the references to other bundles include a replied-to reference." The Examiner has also failed to provide any prior art reference that shows or suggests "references to other bundles." Accordingly, Applicant requests the Examiner to provide an affidavit under 37 C.F.R. Section 1.104(d)(2) detailing the reasons why it is well known, or to provide a prior art reference showing this feature. In the absence of either, Applicant requests the Examiner to withdraw the rejection.

Finally, Applicant respectfully submits that the combination of limitations recited in new claims 44-46 patentably distinguish over the prior art, when each claim is interpreted as a whole.

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CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

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Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

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